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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,495	07/25/2003	Troy Fields	20.2771	1494

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EXAMINER
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COLLINS, GIOVANNA M

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 04/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/604,495

Applicant(s)

FIELDS, TROY

Examiner

Giovanna M. Collins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 4/7/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 2-16, 22, 36-47, 50, 51 and 54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 17-21, 23-35, 48, 49, 52, 53, 55 and 56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20030725, 20040802
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I- bit debris blocker (embodiment of Figs. 8-9);

Species II- filter plug debris blocker (embodiment of Figs. 11-13c);

Species III- sealing plug debris blocker (embodiment of Figs 6a-6c).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1,17-19,52,55-56 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Jennie Salazar on 3/31/05 a provisional election was made with traverse to prosecute the invention of Species I, claims 20-21,23-35,48-49, 52-53 and 55-56. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2-16,22,36-47,50,51,54 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Information Disclosure Statement***

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, the patent 5,195,588 listed in the specification has not been considered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 1 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Urbanosky 3,924,463.

Referring to claims 1 and 17, Urbanosky discloses (figs. 6b) a downhole tool for reducing debris comprising a housing (11) positionable in the open wellbore (at 12), and an arm (42) in the housing and extendable therefrom and at least one debris blocker (46), the debris blocker positioned in the perforation via the arm

4. Claims 1,18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by MacDougall et al. 5,692,565.

Referring to claims 1 and 18-20, MacDougall discloses (figs. 1) a downhole tool for reducing debris comprising a housing (17) positionable in the cased wellbore (at 11), and an arm (18) in the housing and extendable therefrom and at least one debris blocker comprising a bit (19) adapted to create the perforation, the debris blocker positioned in the perforation via the arm and a seal (17b).

Referring to claim 21, MacDougall discloses the bit is positionable in the perforation and is operable with a stationary (before retracting bit) and activated mode (fig. 5), wherein the station mode the bit permits the flow of fluid past the outer surface of the bit wherein preventing the flow of debris and in the activated mode the bit is movable to dislodge debris in the perforation.

5. Claims 23-28,34,48,49,52,53,55,56 are rejected under 35 U.S.C. 102(e) as being anticipated by Bond 6,772,839.

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Referring to claims 23, 52 and 53, Bond discloses a method of reducing debris in a perforation in a wellbore, comprising positioning a downhole tool in the wellbore the tool having a bit (90) extendable therefrom positioning the bit in the perforation to block debris (col. 7, lines 1-8).

Referring to claim 24, Bond discloses creating a perforation in a sidewall of the wellbore (fig. 13).

Referring to claim 25, Bond discloses detecting the debris (col. 1, lines 21-22)

Referring to claims 26 -27, Bond discloses activating the bit to dislodge debris from the perforations by advancing the bit (col. 7, lines 1-8).

Referring to claim 28, Bond discloses plugging the perforation (fig. 18).

Referring to claim, 34, Bond discloses the wellbore (16) is a cased wellbore.

Referring to claims 48-49 and 55-56, Bond disclose testing or sampling the formation fluid via the perforation (col. 1, lines 15-45).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 29 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bond '839 in view of Urbanosky 3,924,463.

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Bond discloses the method of claim but does not disclose a filter. Urbanosky teaches a filter to further filter smaller particles of plugging materials (col. 4, lines 50-56). As it would be advantageous to filter as much of the debris as possible, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Bond to have a filter as taught by Urbanosky.

Referring to claims 31 and 32, Urbanosky teaches filters (45 and 46) that are stacked concentrically.

7. Claims 29-31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bond '839 in view of Taggart 3,430,711.

Bond discloses the method of claim 23 but does not disclose a filter. Taggart teaches a filter to further filter smaller particles of plugging materials in the formation fluid (col. 3, lines 10-16). As it would be advantageous to filter as much of the debris as possible, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Bond to have a filter as taught by Taggart.

Referring to claim 30, Bond does not disclose advancing the bit through the filter. However, Bond discloses permanently plugging the perforation with the bit when testing is complete (col. 12, lines 58-67). As it would be advantageous to fully plug the perforation when the testing period is complete, it would be obvious to one of ordinary skill in the art to modify the bit disclosed by Bond to advance through the filter.

Referring to claims 31 and 33, Bond as modified does not disclose stacking more than one filter linearly in the perforation. However, duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378

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(CCPA 1960). Therefore it would be obvious to one of ordinary skill in the art at the time of the invention to further modify the method disclosed by Bond stack more than more filter linearly because duplicating the components of a prior art device is a design consideration within the skill of the art.

8. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bond '839 in view of Brieger 3,934,468.

Bond discloses the method of claim 23 but does not disclose the wellbore is uncased. Brieger teaches that it is well known in the art to also test uncased wellbores (col. 1, lines 1-26). As one of ordinary skill in the art would be familiar with also having a tool to get samples from uncased well bore, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Bond to test uncased wellbore as taught by Brieger.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 571-272-7027. The examiner can normally be reached on 6:30-3 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
gmc

  
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